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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,516	07/16/2001	Nathalie Mougin	P 0281573 B00/2208 US	2271
909	7590	10/05/2006	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			WANG, SHENGJUN	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1617	
DATE MAILED: 10/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,516

Applicant(s)

MOUGIN ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 27, 28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-25, 27, 28, 30-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' species election submitted July 19, 2006 is acknowledged. On further consideration, the species elected is herein withdrawn in favor of following action.

Claims 1-25, 27-28, 30-34 are pending. Claims 12 and 34 have been withdrawn from further consideration as drawn to non-elected invention. (office action June 27, 2002). Claims 1-11, 13-25, 27, 28, 30-33 are drawn to polyurethane and composition comprising the same. Claim 1-11, and 13-17 have been withdrawn from further consideration for distinct properties of the polyurethane claimed therein, i.e., water-soluble vs. water-dispersible in claim 18 and its dependent claims. An earlier elected species was found allowable, and the search has been extended. Due to the complexity of the subject matter in claim 18, the examiner required further species election. Applicants made election with traverse on the ground that species election has already been made. It has been found that a further sole species election is improper. However, in view the fact of the complexity of claimed subject matter in claim 18 and the undue burden for search the full scope of claimed invention, a restriction within claim 18 is proper.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, Y is polyethylene glycol, Z is oxygen, and R-X-(P)_n- and -(P')_p-X'-R' containing ammonium moieties, and hydrophobic moieties, classified in class 424, subclass 401.

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- II. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, Y is polyethylene glycol, Z is oxygen, and R-X-(P)_n- and -(P')_p-X'-R' containing hydrophobic moieties, but no ammonium moieties, classified in class 424, subclass 401.
- III. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, Y is polyethylene glycol, Z is oxygen, and R-X-(P)_n- and -(P')_p-X'-R' containing no hydrophobic moieties, and no ammonium moieties, classified in class 424, subclass 401.
- IV. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, Y is polyethylene glycol, Z is oxygen, and R-X-(P)_n- and -(P')_p-X'-R' containing ammonium moieties, but no hydrophobic moieties, classified in class 424, subclass 401.
- V. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, Z is oxygen, Y is not polyethylene glycol.
- IV. Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the r is zero,

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- VII Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m is zero.
- VIII Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, and Z is nitrogen.
- IX Claims 18-25, 27-28, 30-33, drawn to a cosmetic composition comprising a amphoteric polyurethane of formula (I) as defined in claim 18, wherein the m and r are not zero, and Z is sulfur.

Inventions groups I-IX are unrelated each from the others. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operation. Particularly, The inventions of Group I-IX represent separate and distinct polyurethane compositions. They differ with respect to ingredients, method steps and final results. They therefore have different issues regarding patentability and enablement and represent patentable distinct subject matter. For examples, process of making polyurethane wherein Z as defined herein is oxygen would be distinct from those wherein Z is nitrogen or sulfur. A polyurethane with Z is oxygen would not make a polyurethane where Z is nitrogen or sulfur obvious. Therefore, there would be different issues regarding enablement, and obviousness. Further, a cationic polyurethane would be distinct from non-ionic polyurethane. A polyurethane with terminal hydrophobic groups would have reasonable expected to change the physical and chemical properties of the polyurethane. It is

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well settled patent law that a Markush group must contain an immutable structural core responsible for the claimed activity. Applicant fails to provide an immutable central core structure for the proffered claims thereby presenting an improper Markush group for examination. Failure to link the claimed compounds with an immutable core structure results in claims reading on more than one invention, requiring restriction under 35 USC 121. Note, polyurethane with hydrophilic group and/or hydrophobic groups are known in the art. See the reference on the record.

The above delineated inventions are independent and patentably distinct each from the other. The grouped inventions differ chemically, a reference which would anticipate the invention of one group would neither anticipate, nor make obvious the inventions in the other groups. The searches are not co-inclusive as indicated by the diverse chemical nature of the subject matter. One skilled in the art would readily practice the invention of one of the above groups without infringing and or practicing the invention of another group. The subject matter is unique and has acquired a separate status in the art and is fully capable of supporting separate patents. For the foregoing reasons restriction is proper for examination purposes.

2. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Species Election

4. Claims 18-25, 27, 28, 30-33 are generic to the following disclosed patentably distinct species: various polyurethane. The species are independent or distinct because their structural distinct features. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument

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that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Note, if the elected invention read on the species elected on September 7, 2004, no further species election is required.

Other Issues

Claims 1-11 and 13-17.

Claims 1-11, 13-17 are herein withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected *invention*. It is noted that the record is not clear whether the claims were withdrawn because of non-elected invention or species.

5. Claims 1-11 and 13-17, drawn to polyurethane are distinct and independent from claims 18-25, 27, 28, 30-33, drawn to a cosmetic composition. The inventions are either unrelated, assume that the polyurethanes in the two inventions are distinct each from the other, or the inventions are related as combination (cosmetic composition) and subcombination (polyurethane). Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because cosmetic composition may be made

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without the employment of the polyurethane. The subcombination has separate utility such as those disclosed in US patent 4,617,431 (Laine et al. of the record).

The general formula (I) in claim 18.

The examiner notes that general formula (I) in claim 18 is not only complex, but also sometime, confusing as to the compounds encompassed thereby. For examples, when m is zero, it would require L directly linked to L or L'. If Z is oxygen, it would lead to -O-O- bonding which is very unstable. For another example, when p and p' are zero, and X and X' are amine, such as the polyurethane elected in the response filed July 19, 2006, which would lead to a polyurethane with a terminal group of -O-N-(R)₃. Such kind of polyurethane is unusual, and substantially detailed written description may be required for such compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHENGJUN WANG
PRIMARY EXAMINER
Shengjun Wang
Primary Examiner
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